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| 44596 7590 12/28/2009 DR. MARK M. FRIEDMAN C/O BILL POLKINGHORN - DISCOVERY DISPATCH 9003 FLORIN WAY UPPER MARLBORO, MD 20772 | | | | |
| EXAMINER SHERR, CRISTINA O | | | | |
| ART UNIT 3685 | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mark_f@friedpat.com
nomi_m@friedpat.com
friedpat.uspto@gmail.com

Office Action Summary

Application No.

10/612,921

Applicant(s)

ZUNKE ET AL.

Examiner

CRISTINA SHERR

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 15-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to Applicant's Amendment filed August 16, 2009. Claims 1-25 are pending in this case. Claims 1-5 and 23-24 are currently amended. Claims 25 is newly added. Claims 15-22 have been previously withdrawn. Accordingly, Claims 1-14 and 23-25 are under examination.

Response to Arguments

2. Applicant's arguments filed August 16, 2009 have been fully considered but they are not persuasive.

3. Applicant argues, regarding claim 1, as currently amended, that the section 101 rejection of claim 101 is inappropriate.

4. Examiner respectfully disagrees. In this case, claim 1, as currently amended, is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008). Note that the steps of "conducting . . ." and "monitoring . . ." are not recited as being performed by any apparatus or device.

5. Applicant's arguments with respect to the section 112 rejection of the claims, as currently amended, have been considered but are moot in view of the new ground(s) of rejection under section 112.
6. Applicant argues, regarding the section 103 rejection of claim 1, as amended, that nothing in the cited prior art teaches, discloses or suggests the modification of a license my one or more users.
7. Examiner respectfully disagrees. Ginter at col 255 ln 57 – col 256 ln 7 discloses modification of a license by a user or users, where further at col 256 ln 50-55 Ginter recites that all "participants of VDE100 have the innate ability to participate in any role".
8. Applicant argues, regarding claim 1, that nothing in the cited prior art teaches, discloses or suggests the limitation "implementing of the second policy utilizes at least one optimization method".
9. Examiner respectfully disagrees. Salas discloses determining a licensing policy according to the monitoring of at least one parameter to obtain a determined licensing policy (e.g. col 1 ln 32-60). Ginter discloses optimizing a determined policy according to its evaluation or re-evaluation . (e.g. col 48 ln 12-45).

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 1-14 and 23-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

12. In this case, claim 1, as currently amended, is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008). Note that the steps of "conducting . . ." and "monitoring . . ." are not recited as being performed by any apparatus or device.
13. For these reasons, independent claim 1, and its dependent claims 2-14 and 23-25 are rejected under section 101.

Claim Rejections - 35 USC § 112

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
15. Claims 1-14 and 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. In this case, Applicant uses, in claim 1, as currently amended, the term "tolerant" to describe a licensing policy without explaining tolerant of what. Thus, the language of the claims fails to properly set forth the metes and bounds of the invention.

17. Thus, claim 1, and its dependent claims 2-14 and 23-25 are rejected under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1-14 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al (US 6,253,193) in view of Salas et al (US 6,314,408).

20. Regarding claims 1, 23, and 24 –

21. Ginter discloses a method for determining a licensing policy of using at least one digital product by at least one user, comprising the steps of:

conducting a tolerant first licensing policy for the use of the at least one digital product by the at least one user during a trial period; monitoring at least one parameter of said use during said trial period, wherein said steps is conducted by a server (e.g. col 3 In 20-50).

22. Ginter does not disclose, but Salas, does, determining a licensing policy according to said monitoring of said at least one parameter to obtain a determined

licensing policy (e.g. col 1 ln 32-60). Ginter discloses optimizing a determined policy according to its evaluation or re-evaluation . (e.g. col 48 ln 12-45).

23. Additionally, Ginter at col 255 ln 57 – col 256 ln 7 discloses modification of a license by a user or users.

24. It would be obvious for one of ordinary skill in the art to combine the teachings of Ginter, Stefik and Salas as they are in the same art and in order to obtain greater flexibility in the granting of licenses.

25. Regarding claims 2-6 –

26. Ginter discloses the method of claim 1, wherein said step of monitoring includes collecting at least one sample of said at least one parameter, and wherein said step of determining includes evaluating the performance of said tolerant licensing policy according based on said at least one sample; further comprising steps of, in at least one loop, re-evaluating said determined licensing policy, and optimizing said determined policy according to said re-evaluation; wherein said tolerant licensing policy comprises at least one rule being less restrictive than a corresponding rule of said determined licensing policy; wherein said tolerant licensing policy includes free usage of the at least one digital product during said trial period; wherein said at least one parameter is selected from a group consisting of a time count and a run count (e.g. col 48 ln 12-45).

27. Regarding claims 7-8 –

28. Ginter discloses the method of claim 6, wherein said time count is selected from the group consisting of the time of posting of a request for a license, the time a license is

29. in use by a user, and the average time a user has to wait in a licensing queue until a license is issued; wherein said run count is selected from the group consisting of the number of times licenses have been issued, the number of times a license has been requested, and the number of times a user gave up requesting a license (e.g. col 53 In 20-50).

30. Regarding claims 9-13 –

31. Ginter discloses the method of claim 1, wherein said at least one user is selected from the group consisting of at least one machine, at least one organization and at least one department of an organization; wherein said at least one user is defined manually; wherein said at least one user is defined automatically; wherein said at least one user is selected from the group consisting of the first N users that invoked said product during a first predefined period, the first N users that used said product for at least a predetermined duration during a predefined period, and a combination thereof; further comprising ranking said at least one user, and issuing a license to the user having the highest rank among the users waiting in a licensing queue (e.g. col 64 In 40-55).

32. Regarding claim 14 –

33. Ginter discloses a method according to claim 13, wherein the rank of a user waiting in a licensing queue is upgraded according to the waiting time of said user in said queue (e.g. col 64 In 50-55).

34. Regarding claim 25 –

35. Ginter discloses wherein the plurality of users that implements said second licensing policy includes at least one end-user of the at least one digital product. col 255 In 57 – col 256 In 7 discloses modification of a license by a user or users, where further at col 256 In 50-55 Ginter recites that all "participants of VDE100 have the innate ability to participate in any role".)

Conclusion

36. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

37. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

39. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRISTINA OWEN SHERR
Examiner
Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685